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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,554	03/08/2002	Yasutaka Ishii	3273-0153P	1456
2292	7590	08/10/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SHIAO, REI TSANG	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/092,554

Applicant(s)

ISHII ET AL.

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☒ Claim(s) 1, 2, 10-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/03/2004 1/30/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This application claims benefit of the foreign application:  
JAPAN 067633 with a filing date 03/09/2001.
2. Applicant's amendment including cancellation of claims 5-9, and addition of claims 10-14 in Paper No. 0304, dated March 12, 2004, is acknowledged. Claims 1-4, 10-14 are pending in the application. No new matter is found. Since claims 10-14 are commensurate with the scope of invention, therefore, claims 1-4 and 10-14 are prosecuted in the case.

### ***Responses to Arguments***

3. Applicant's arguments regarding the rejection of claims 3-4 under 35 U.S.C. 102 (a) and 103(a) filed on March 12, 2004 have been fully considered and they are persuasive. Since the publication date of Sawatari et al. publication, J. of Organic Chemistry, 2001,66:7889-7891, is October 18, 2001, which is later than the instant foreign priority, dated March 09, 2001. Therefore the rejection of claims 3-4 under 35 U.S.C. 102 (a) and 103(a) is withdrawn herein. Since claims 1-4 are commensurate with the scope of invention, therefore, the withdrawal of claims 1-4 set forth in the previous Office Action, dated February 12, 2004, is obviated.
4. Applicant's arguments regarding the rejection of claims 3-4 under obviousness-type double patenting over Ishii et al. US 6,232,258 filed on March 12, 2004, have been fully considered but they are not persuasive. It is noted that the common inventor Yasutaka Ishii invented the invention of US 6,232,258 and the instant invention. A filed

terminal disclaimer is requested to overcome the rejection set forth in the previous Office Action, dated August 22, 2003.

### ***Objection***

5. Claims 1-2 are objected to as containing duplicated formula (I) having distinct chemical structure. It is noted that the formula (I) of claim 1 is a pyrrolidine moiety substituted with two methyl, while the formula (I) of claim 2 is a pyrrolidine moiety substituted with variables  $R^1$  and  $R^2$ . Clarification is required.
6. Claims 3 and 10 are objected. In claim 3, line 5-6, recites the phrase "wherein the groups  $-C(=O)-OR^x$  may be the same or different when n is equal to or more than 2", is ambiguous. It is noted that the instant N-hydroxyphthalimide moiety of formula (II) of claims 3 or 10 is substituted with only one  $-C(=O)-OR^x$  when the variable n is more than 1 at the benzene ring. Clarification is required.
7. Claims 13-14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. It is noted that the instant N-hydroxyphthalimide moiety of formula (II) of claims 3 or 10 is substituted with only one  $-C(=O)-OR^x$  when the variable n is more than 1 at the benzene ring, while two substitutents  $-C(=O)-OR^x$  are found in the named chemical 4,5-bis(octyloxycarbonyl)-N-hydroxyphthalimide of claims 13-14.

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*R.S.*  
Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

*for* *R. McKane*  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

*8/4/04.*

August 3, 2004